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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,372	11/25/2003	Alexandre M. Mayolet	SP00-140B	8015
22928	7590	04/25/2006	EXAMINER	
CORNING INCORPORATED			HOFFMANN, JOHN M	
SP-TI-3-1				
CORNING, NY 14831			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/723,372	MAYOLET ET AL
	<b>Examiner</b>	<b>Art Unit</b>
	John Hoffmann	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 March 2006 and 12 October 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 25-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 25 is/are allowed.
- 6) Claim(s) 26-35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Terminal Disclaimer***

The terminal disclaimer filed on 10/12/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6699408 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Information Disclosure Statement***

The information disclosure statement filed 12 October 2005 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed 12 October 2005 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted **on each page of the list**; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for measuring the absorption to provide the qualified lens blank (as claimed in claim 26); or the exposing/detecting to provide the qualified lens (as indicated in claim 31) – either explicit or implicit. Furthermore, Examiner could find nothing to support the claim 26 limitation that the exciting (line 4) of the member is part of the measuring of the absorption spectrum; it appears these are two different tests. This is deemed to be a *prima facie* showing on failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply.

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Further from the sentence spanning pages 8-9 of the specification, one should not use the 193 nm data to qualify the 157 nm transmission data. Thus it would seem that Applicant would need an explicit support/suggestion the 200-220/203/205 data could be used for qualifying/providing a specific 157 nm level.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27 and 31-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 refers to measuring – it is unclear if it refers back to the measuring of claim 25, the measuring of claim 26, or if it is a new measuring. Claim 30 is indefinite for the same reason.

Claim 31: it is unclear if the “detecting radiation diffracted” (lines 3-4) is in addition to that of claim 25, or if it merely repeats the same detecting.

### ***Response to Arguments***

Applicant's arguments filed 10/12/2005 have been fully considered but they are not persuasive.

As to item 1 on page 6 of the 10/12/2005, it is argued that pages 12, 7 and 8 provide the support for the step of measuring to provide the qualified lens. Applicant's arguments do point to support for the measuring, but there is no mention of doing such

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"to provide" the lens blank as required by the claims. Examiner could find nothing in the cited passages that suggests that the testing provides the lens blank. Rather, those pages suggests that the blank would have been provided by the crystallizing or annealing or some unclaimed shaping step.

As to item 2, it is argued that pages 5-7 state the diffractometric techniques can be used to meet boundary requirements. Examiner disagrees, the specification gives no indication that the diffractometric techniques can be used to meet/make the boundaries. As pointed out at the top of page 6 of the specification indicates that the test merely distinguishes between the crystals that meet the requirements and those that do not. To the degree that applicant's position is that "providing" is merely "distinguishing" – Examiner could find support for such an interpretation.

As to item 3 on page 7: the rejection is dropped. Examiner notes that the last originally filed claim 23 provides support for claim 25(b).

At item 4 of page 7 of the 10/12/2005 response it is argued that luminescence occurs in three stages – including absorption and emission (examiner believes this is true). It is then argued that one can expose the crystalline member to 203 nm light to measure transmittance and/or luminescence. This also seems to be true but not very relevant. The claim does not refer to transmittance, rather absorption (spectrum). To measure an absorption spectrum, one has to irradiate with light of the entire spectrum, not just 203 nm. To look at it another way, if the member is excited during an

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absorption test, one cannot determine whether some of the light which is detected was transmitted light or light emitted due the luminescence. See page 8, lines 3-9 of the specification. To examiner, the plain reading is that light from 190-300 nm was transmitted through the member to determine the absorption of the 190-300 nm wavelengths, then in a separate test, 203 nm light was used to excite the sample. There is nothing which suggest they are part of the same measuring step as required by claim 26.

As to item 5, of page 8, it is argued that the statement that Examiner mentioned is not necessary. Applicant then goes on to point to where the various qualifications are given on page 9. Examiner does not understand the relevance. Page 9 gives no indication as to how the 157 absorption criteria is made. And there surely is no mention of it being made with the 200-220nm or 203 nm light as required by claim 26.

Regarding claim 27 it is argued that the claim is clear when read in light of figure 6 and page 7, line 28 to page 8, line 8. This is deemed to be irrelevant. The claims must be read in light of the entire specification – not just a few limited portions. When one reads the ENTIRE specification, one notices that there are numerous tests mentioned – not just the ones of figure 6 and page 7, line 28 to page 8, line 8. As pointed out in the rejection, one cannot tell which measuring claim 27 refers back to.

As to claim 30 the point that it further limits 26 is not understood. The claim is rejected because one would not be able to tell which measuring step it refers back to – if at all. The arguments do not address this – and thus the rejection is maintained.

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As to claim 31 it is argued that the wherein clause recites "wherein detecting radiation diffraction includes..." which would be understood by one as referring back to the referring of claim 25. This appears to be irrelevant. The rejection is based on the detecting of lines 3-4 of claim 31. The arguments are limited to the detecting of line 1. Examiner does not dispute that this line 1 is the same detecting as mentioned in claim 25.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Hoffmann  
Primary Examiner  
Art Unit 1731

4-24-06

jmh